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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/467,168	12/20/99	OATHOUT J	SS2945

EXAMINER	
BEFUMO,J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/467,168	OATHOUT, JAMES MARSHALL	
	Examiner	Art Unit	
	Jenna-Leigh Befumo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the corr spondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-7 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☐ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5 .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 - 7, drawn to a method of using a non-woven fabric, classified in class 15, subclass 210.1.

II. Claims 8 - 15, drawn to a non-woven fabric, classified in class 442, subclass 408.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the non-woven fabric can be used in medical garments or drapes.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Frederick Strickland on July 9, 2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 - 7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8 - 15 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 – 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1 - 7 provide for the use of a non-woven fabric, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1 - 7 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

8. Since claims 1 – 7 fails to set forth method of using limitations, the claims will be examined based on the positive limitations. Thus, claims 1 – 7 will be examined based on the structural limitations of the non-woven fabric.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 – 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's Admission (Specification, pages 10 – 13).

Applicant discloses that the fabric used in example 4 is a commercially available hydro-entangled non-woven fabric comprising 42% lyocell and 58% polyethylene terephthalate. Table 2 shows that the fabric in example 4 has a dynamic wiping efficiency of 91.8% at a capacity of 10 mL. Table 3 shows the dynamic wiping efficiency for the same cloth is 84% when the capacity is approximately 130%. In Table 5, the particle removal efficiency of example 4 is 99.27% at a capacity of 10 mL and 98.97% at a capacity of 130%. Thus claims 1 – 7 are anticipated by Applicant's Admissions.

Claim Rejections - 35 USC § 102/103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1 – 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Paley et al. (4,888,229).

Paley et al. disclose a wiping material which can be used in cleanroom environments (column 1, lines 55 – 61). The wiping material can be made with thermoplastic materials, such as polyesters (column 2, lines 50 – 55). Polyethylene terephthalate is a popular type of polyester material. The wiping fabric can be made in the form a woven, knitted, or non-woven fabric (column 2, lines 56 – 57).

Although Paley et al. does not explicitly teach the limitations of dynamic wiping efficiency and particle removal efficiency, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyethylene terephthalate fibers) and in the similar production steps (i.e. formed as a non-woven fabric) used to produce the wiping material. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the fabric disclosed by Paley et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

13. Claims 1 – 5 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson et al. (GB 2 309 466 A).

Johnson et al. disclose a hydro-entangled fabric comprising lyocell fibers (abstract). Although Johnson et al. does not explicitly teach the limitations of dynamic wiping efficiency and particle removal efficiency, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. lyocell fibers) and in the similar production steps (i.e. hydro-entangling the fibers) used to produce the non-woven fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the fabric disclosed by Johnson et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paley et al. in view of Johnson et al.

The features of Paley et al. and Johnson et al. have been set forth above. Paley et al. fails to teach making the non-woven fabric by hydro-entanglement. Johnson et al. discloses that preparing non-woven using the hydro-entanglement process maintains good absorbency since the additional binders, which would interfere with the good absorbency characteristic, are not needed to bond the fabric together (page 1, lines 18 – 24). Therefore, it would have been obvious to one having ordinary skill in the art to make the non-woven wiping fabric of Paley et al. by hydro-entangling to maintain the absorbency characteristics of fabric. Also, since the binder is not need to make the fabric less chemicals are required making the process cheaper and more efficient.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (8:00am - 4:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
July 30, 2001

CHERYL JUSKA
PATENT EXAMINER